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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 516,310	03-01-2000	Yao-Zhong Lin	22000.0021U2	3622

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EXAMINER

LOEB, BRONWEN

ART UNIT

PAPER NUMBER

1636

DATE MAILED: 12/14/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/516,310

Applicant(s)

LIN ET AL.

Examiner

Bronwen M. Loeb

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 6-26, 32 and 33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 6-26, 32 and 33 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 32, drawn to a complex comprising an importation competent signal peptide, classified in class 514, subclass 1.
- II. Claims 6-10, drawn to a method of importing a biologically active molecule into a cell, classified in class 514, subclass 1.
- III. Claims 11-13, drawn to a method of importing a biologically active molecule into the nucleus of a cell wherein the nuclear localization peptide is SEQ ID No. 2, classified in class 514, subclass 1.
- IV. Claims 11, 12 and 14, drawn to a method of importing a biologically active molecule into the nucleus of a cell wherein the nuclear localization peptide is SEQ ID No. 10, classified in class 514, subclass 1.
- V. Claims 11, 12 and 15, drawn to a method of importing a biologically active molecule into the nucleus of a cell wherein the nuclear localization peptide is SEQ ID No. 11, classified in class 514, subclass 1.
- VI. Claims 16-19 and 21, drawn to a method of regulating the growth of a cell in a subject wherein the growth regulatory peptide comprises SEQ ID No. 3, classified in class 514, subclass 1.

- VII. Claims 16-18, 20 and 21, drawn to a method of regulating the growth of a cell in a subject wherein the growth regulatory peptide comprises SEQ ID No. 4, classified in class 514, subclass 1.
- VIII. Claims 16-18, 20 and 22, drawn to a method of regulating the growth of a cell in a subject wherein the growth regulatory peptide comprises SEQ ID No. 9, classified in class 514, subclass 1.
- IX. Claims 23-25, drawn to a method of inhibiting in a cell in a subject of a gene controlled by transcription factor NF- $\kappa$ B, classified in class 514, subclass 2.
- X. Claim 26, drawn to a method of stimulating the immune system of a subject, classified in class 514, subclass 2.
- XI. Claim 33, drawn to a method of screening signal peptides for the ability to effect the importation of a biologically active molecule into a cell, classified in class 435, subclass 4.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II-XI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the complex of

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Group I may be used in numerous materially different processes as evidenced by the many different processes claimed.

Inventions II-XI are distinct methods from each other, having different starting material, different outcomes and different uses.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and require different searches, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Conclusion***

Certain papers related to this application may be submitted to Art Unit 1636 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone numbers for the Group are (703) 308-4242 and (703) 305-3014. NOTE: If Applicant does submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bronwen M. Loeb whose telephone number is (703) 605-1197. The examiner can normally be reached on Monday through Friday, from

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10:00 AM to 6:30 PM. A phone message left at this number will be responded to as soon as possible (usually no later than the next business day after receipt by the examiner).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Elliott, can be reached on (703) 308-4003.

Any inquiry of a general nature or relating to the status of this application should be directed to Dianiece Jacobs, Patent Analyst whose telephone number is (703) 305-3388.

Bronwen M. Loeb, Ph.D.  
Patent Examiner  
Art Unit 1636

November 30, 2001



REMY YUCEL, PH.D  
PRIMARY EXAMINER